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Date: December 16, 2004
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Re: 09/991,202

Number of Pages Including this Page 4

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MESSAGE:

US Serial No.: 09/991,202
Filing Date: November 21, 2001
Group Art Unit: 2812
Docket No: 01-555
Examiner: Stanetta D. Isaac
Response to Restriction Requirement

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PTO/SB/21 (09-04)

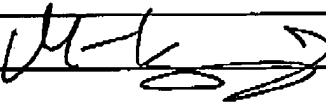
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/991,202	
	Filing Date	11/21/2001	
	First Named Inventor	Venkatcsh P. Gopinath, et al.	
	Art Unit	2812	
	Examiner Name	Stanetta D. Isaac	
Total Number of Pages in This Submission	3	Attorney Docket Number	01-555

ENCLOSURES (Check all that apply)		
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Remarks Response to Restriction Requirement		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	LSI Logic Corporation	
Signature		
Printed name	Timothy R. Croll	
Date	12/16/2004	Reg. No. 38,771

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Date	12/16/2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Venkatesh P.)
 Gopinath, et al.) Group Art Unit: 2812
)
) Examiner: Stanetta D. Isaac
 Serial No.: 09/991,202)
) Atty. Docket No.: 01-555
 Filed: November 21, 2001)
)
 For: Shallow Trench Isolation Structure)
 With Low Trench Parasitic Capacitance)
)

RESPONSE TO OFFICIAL ACTION
Second Restriction/Election Requirement

Hon. Commissioner of Patents and Trademarks
 Washington, D.C. 20231

Sir:

This response is presented to the Office Action mailed November 29, 2004, wherein the Examiner required *yet another* restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group I, method claims 1-25.

Remarks/Arguments

Reconsideration of the restrictions are respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted...." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

In searching the Group I claims, the class and subclass for the Group II claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent